

## REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 8, 2009. At the time of the Office Action, Claims 1-58 were pending in this Application. Claims 2, 3 and 41-56 were previously withdrawn due to an election/restriction requirement. Claims 1, 4-40, 57 and 58 were rejected. Claims 1, 5, 10, 15, 17, 19-20, 25, 29-30, 33, and 35 have been amended to further define various features of Applicants' invention. Claim 4 has been cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

### **Specification Amendments**

Applicants amend the specification hereto by inserting a paragraph for the related application data.

### **Rejections under 35 U.S.C. §102**

Claims 1, 4-9, 17-26, 28-30, 33-34 and 57-58 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0163126 by West ("West"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claims 1, 17, and 29, West does not describe an active electrode disposed along a portion of the tissue removal port perimeter, as is now recited by amended claims 1, 17, and 29. Rather, West describes an instrument with a plurality of peg-shaped electrodes disposed at a distal end of the device. Because West does not describe every element of amended claims

1, 17, and 29, West cannot anticipate claims 1, 17, and 29 as amended. For at least these reasons, Applicants submit that amended claims 1, 17, and 29 are in condition for allowance and respectfully request withdrawal of the rejection.

Claims 5-9 and 57-58 depend directly or indirectly from claim 1. Claims 18-26 and 28 depend directly from claims 17. Claims 30 and 33-34 depend directly from claims 29. Applicants hereby repeat and incorporate the above comments made with respect to amended claims 1, 17, and 29. For at least these reasons, Applicants submit that claims 5-9, 18-26, 28, 30, 33-34, and 57-58 are in condition for allowance and respectfully request withdrawal of the rejection.

#### **Rejections under 35 U.S.C. §103**

Claims 10, 12, 15-16, 35-37 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of U.S. Patent Application Publication No. 2002/0038122 by Peters ("Peters").

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of Peters as applied to claim 10 above, and further in view of U.S. Patent No. 4,203,444 issued to Bonnell et al. ("Bonnell").

Claims 13 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of Peters as applied to claims 10 and 35 respectively above, and further in view of U.S. Patent Application Publication No. 2001/0025177 by Woloszko et al. ("Woloszko").

Claims 14 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of Peters as applied to claims 10 and 35 respectively above, and further in view of U.S. Patent No. 5,423,844 issued to Miller ("Miller").

Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over West as applied to claim 17 above, and further in view of Miller.

Claims 31 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over West as applied to claim 29 above, and further in view of U.S. Patent No. 6,032,673 issued to Savage et al. ("Savage"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

With regard to claim 10, none of the cited references at least suggest a method for the removal of tissue by use of an instrument having an active electrode disposed on at least a portion of the perimeter of the tissue removal port and an active electrode adapted for electrosurgically removing the target tissue via molecular dissociation as the rotating member leading edge repeatedly manipulates the target tissue toward the active electrode. Therefore the cited references cannot render obvious claim 10 as amended. For at least these reasons, Applicants respectfully submit that claim 10 is in condition for allowance, and request withdrawal of the rejection.

Claims 11-16 depend directly from claim 10. Applicants hereby repeat and incorporate the above comments made with regard to amended claim 10. For at least these reasons, Applicants submit that claims 11-16 are in condition for allowance, and respectfully request withdrawal of the rejection.

With regard to claim 35, none of the cited references at least suggest an active electrode disposed on at least a portion of the perimeter of the tissue removal port. Additionally, none of the cited references describe the step of sequentially removing tissue by applying the high frequency voltage between the active electrode and the return electrode and rotating the leading edge of a rotating member so as to repeatedly manipulate the target tissue toward the active

electrode. Therefore, the cited references cannot render obvious claims 35 as amended. For at least these reasons, Applicants respectfully submits that claim 35 is in condition for allowance, and request withdrawal of the rejection.

Claims 36-40 depend directly from claim 35. Applicants hereby repeat and incorporate the above comments made with regard to amended claim 35. For at least these reasons, Applicants submit that claims 36-40 are in condition for allowance, and respectfully request withdrawal of the rejection.

**Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 for the IDS and any additional fees necessary or credit any overpayments to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
Attorney for Applicants,



Matthew Scheele  
Reg. No. 59,847

Date:

9/18/09

CORRESPONDENCE ADDRESS:

ARTHROCARE CORPORATION

CUSTOMER NO. **21394**

512.358.5925

512.391.3901 (fax)

Enclosure: 1) Information Disclosure Statement and PTO Form 1449, with copies of the references.